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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,209	12/04/2003	Homero Ramirez Tobias	224387	8004

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EXAMINER

GREEN, ANTHONY J

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/728,209

Applicant(s)

RAMIREZ TOBIAS ET AL.

Examiner

Anthony J. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/04/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, drawn to concrete based floor and wall coverings, classified in class 106, subclass 15.05.
- II. Claims 6-9, drawn to a method of manufacturing floors and wall coverings, classified in class 264, subclass 333.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as one not requiring the particulars of Group II, namely one in which typical concrete casting is used followed by surface treatment with a microbicide.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Kenneth Spina on 12 May 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-5. Affirmation of this election must be made by applicant in replying to

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this Office action. Claims 6-9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Specification

6. The disclosure is objected to because of the following informalities:

In the specification on page 4, lines 3 and line 23, and on page 6, line 6, the term "application" should be changed to -- patent -- since the references are a patents not applications.

On page 4, line 5, "Mayumi" should be -- Inque --.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 2-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 2 the phrase "an integral part of the mixture" is not understood.

What is applicant trying to say? Clarification is requested.

Claim 4 contains improper Markush terminology as the phrase "or a mixture thereof" should be -- and a mixture thereof --.

In claim 5 the use of the term "preferably" renders the claim indefinite because it is unclear whether the limitations following the term are part of the claimed invention and the scope of the claim is unascertainable. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-2 and 4-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Freed (US Patent No. 6,162,845).

The reference teaches, in the abstract and the claims, a concrete product having antimicrobial treated products contained therein. According to column 3, lines 35+, the types of products envisioned include stucco etc.

The instant claims are met by the reference. Since stucco is made up of cement and aggregates it is the position of the examiner that it is concrete based

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and since it is known as a wallcovering material it is the position of the examiner that the instant claims are met by the reference. With respect to claim 5 since the reference teaches the use of Microban (see column 5, lines 35+) as the antimicrobial agent this claim is met by the reference.

11. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Tozaka (US Patent No. 6,350,305).

The reference teaches, in the abstract and the claims, a constructional based material containing hinokitiol. The constructional based material includes stucco and concrete. According to column 6, lines 1+, the material may be used for walls or floors.

The instant claims are met by the reference as the reference teaches a product that encompasses that which is instantly claimed.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merkley et al (US Patent No. 6,777,103).

The reference teaches, in the claims, and in column 5, lines 9+, a building material comprising a cementitious binder, silica aggregate, biocide treated rot resistant cellulose fibers, density modifiers and additives.

The instant claims are obvious over the reference. While the reference does not specifically recite the formation of a concrete based floor and wallcovering it does teach the formation of a building material comprising cement and aggregate and since cement and aggregate make up concrete the formation of a concrete product is suggested. As for the formation of a floor and wallcovering since the reference suggests the formation of a building material, this would suggest the formation of a floor and wallcovering as they are both well known building materials produced using cementitious compositions. As for the amounts recited in claim 3 one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by the reference overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

“The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages”, In re Peterson 65 USPQ2d 1379 (CAFC 2003).

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Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05. As for the type of microbicide recited in claim 4, the reference suggests the use of pentachlorophenol which would render obvious the use of phenol derivatives absent evidence showing otherwise. Accordingly the instant claims are obvious over the reference.

14. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yeager et al (US Patent No. 5,421,867)

The reference teaches, in column 5, lines 19+, the addition of copper-8-quinolinate into a backerboard slurry mix comprising Portland cement, sand, small aggregate and a fiber glass mesh cloth.

The instant claims are obvious over the reference. While the reference does not recite the formation of a concrete based floor and wallcovering it does teach the formation of a backerboard comprising cement, sand and aggregate (the known components of concrete) and a microbicide which would suggest the formation of a concrete based wallcovering absent evidence to the contrary. With respect to claim 3 which the reference does not teach the use of the same amounts it does suggest the formation of a composition comprising the same components and accordingly the determination of optimal amounts is considered a matter of obvious choice or design best determinable through routine experimentation and optimization within the art and producing no unexpected

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results absent evidence showing otherwise. Accordingly the instant claims are obvious over the reference.

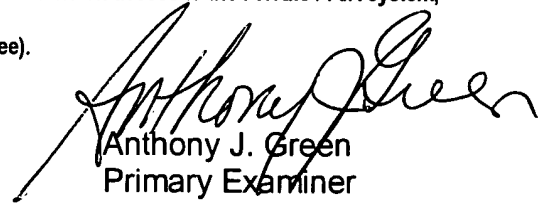
Information Disclosure Statement

15. The remaining references have been considered however they are not seen to be any more pertinent than the art used in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Anthony J. Green
Primary Examiner
Art Unit 1755

ajg
May 13, 2005